No. 22163

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JOHN BOYCE, an individual, and
FMC CORPORATION, a corporation,
Appellants and Cross-Appellees,

vs.

EARL R. ANDERSON, an individual, and
FILPER CORPORATION, a corporation,
Appellees and Cross-Appellants.

REPLY BRIEF OF APPELLANTS AND CROSS-APPELLEES

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TOPICAL INDEX

TABLE OF AUTHORITIES CITED

Cases

Rules

Statutes

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REPLY BRIEF OF APPELLANTS AND CROSS-APPELLEES

INTRODUCTION

The brief for Appellees and Cross-Appellants raises essentially two issues on this appeal, the first of which questions is the jurisdiction of the Trial Court to entertain this action, and the second of which relates to the alleged prior public use under Title 35 USC 102. The Opening Brief of Appellants and Cross-Appellees fully answers those issues raised with respect to the alleged public use. Consequently, this brief will be limited to the jurisdictional problem.

THE TRIAL COURT DID NOT LACK JURISDICTION

The original Complaint herein was filed on April 30, 1962 concededly within the period necessary to invoke the jurisdiction of the Trial Court under Title 35 USC 146. A Motion to Dismiss was filed asserting that the Court lacked jurisdiction on the ground that the Complaint failed to contain a specific allegation to the effect that no appeal had been taken to the United States Court of Customs and Patent Appeals.

The Motion to Dismiss was granted with leave to amend, and the First Amended Complaint was filed June 11, 1962 which, in Paragraph V thereof, contained an allegation to the effect that "no previous appeal to the United States Court of Customs and Patent Appeals having been taken". A renewed Motion to Dismiss was filed on the theory that the original defect in the Complaint was jurisdictional and could not be cured by amendment. This renewed Motion to Dismiss was denied.

The Appellants and Cross-Appellees have failed either in the Court below or in this Court to cite any authority to the proposition that this allegation in the Complaint is even necessary. It is perfectly obvious that the filing of the Complaint in the District Court in and of itself constitutes an election under Title 35 USC 146 and that jurisdiction resides in the District Court unless it can be affirmatively established that a prior appeal has been taken to the United States Court of Customs and Patent Appeals.

Assuming, however, for the sake of argument, that such an allegation is necessary, neither *Klumb v. Roach*, 151 F.2d 374 (7 Cir. 1945) nor *Union Carbide Corp. v. Traver Investment, Inc.*, 201 F.Supp. 763 (SD Ill. 1962) sup-

ports the position that the failure to include the above-referred to allegation is jurisdictional. In each of these cases the complaint failed to name an indispensible party and each case was dismissed on this basis. Rule 15 of the Federal Rules of Civil Procedure provides, in part:

> "(a) . . . otherwise, a party may amend his pleading only by leave of the court or by written consent of the adverse party; and leave shall be freely given when justice so requires . . ."

Rule 15(c) of the Federal Rules of Civil Procedure provides, in part:

> "(c) . . . Whenever the claim or defense asserted in the amended pleading arose out of the conduct, transaction, or occurrence set forth or attempted to be set forth in the original pleading, the amendment relates back to the date of the original pleading. . . ."

Obviously, therefore, the amendment of the pleading in this case relates back to the date of filing of the original Complaint, assuming, again, that such an allegation is necessary in the Complaint.

It was clearly within the knowledge of the Appellees and Cross-Appellants that no appeal had been taken to the Court of Customs and Patent Appeals. There is no conceivable way they could have been prejudiced at all by the procedure adopted by the Trial Court. Therefore, this ground for appeal must fail, first, because there is no authority for the proposition that such an allegation is necessary in the Complaint; second, there is no authority for the proposition that such an allegation is jurisdictional and third, there is no authority for the proposition that the lack of such an allegation cannot be cured by amending the original Complaint under Rule 15 of the Federal Rules of Civil Procedure.

A Complaint should plead only the "ultimate facts" as distinguished from evidentiary facts. The practice of pleading in patent cases was changed to eliminate and dispense with prolix and redundant averments thus eliminating the necessity of pleading affirmatively those statutory requirements to negative the requirements of Rev. Stats. § 4886 and 4887, *Mumm v. Decker & Sons,* 301 U.S. 168, 81 L.ed 982 (1937); *Graff v. Nieberg,* 233 F.2d 860 (1956); and *Price Vacuum Stores v. Admiral Corp.,* 223 F.2d 269 (1955).

CONCLUSION

It is therefore respectfully submitted that the Court did have jurisdiction of this cause and that this ground of appeal must fail for the reasons set forth in the Opening Brief of Appellants and Cross-Appellees. It is further submitted that no prior public use or sale within the provisions of Title 35 USC 102 have been established and the decision of the Trial Court must therefore be reversed.

Respectfully submitted,

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Attorneys for Appellants and Cross-Appellees

CERTIFICATE

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

By: _____

R. Douglas Lyon

Attorney for Appellants and Cross-Appellees